

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 36

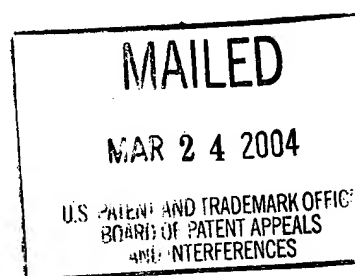
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SUSAN M. DALUGE and
MICHAEL TOLAR

Appeal No. 2003-1216
Application No. 08/957,045

HEARD: March 4, 2004



Before WINTERS, WILLIAM F. SMITH, and GREEN, Administrative Patent Judges.

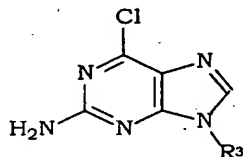
WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 9 and 18 through 22, which are all of the claims remaining in the application.

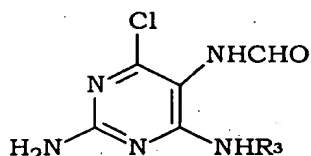
Claims 9 and 20, which are illustrative of the subject matter on appeal, read as follows:

9. A process for the preparation of a compound of formula (VII)



(VII)

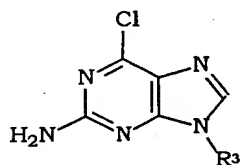
wherein R^3 is hydrogen; hydroxyl; a C_{3-7} carbocyclic group, optionally substituted with substituents selected from the group consisting of C_{1-4} alkyl, C_{1-4} alkoxy, hydroxyl or protected hydroxyl, azido, phosphonyl, and halogen; and acyclic group, wherein such acyclic groups [sic] may be optionally substituted with substituents selected from the group consisting of C_{1-4} alkyl, C_{1-4} alkoxy, hydroxyl or protected hydroxyl, azido, phosphonyl, and halogen; or a C_{4-7} heterocyclic group, wherein said C_{4-7} heterocyclic group has a one or more heteroatoms selected from the group consisting of a N, O and S atom and wherein such C_{4-7} heterocyclic group may be optionally substituted with substituents selected from the group consisting of C_{1-4} alkyl, C_{1-4} alkoxy, hydroxyl or protected hydroxyl, azido, phosphonyl, and halogen; provided that such groups are not attached by a glycosidic bond; comprising reacting a compound of formula (VI).



(VI)

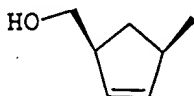
wherein R^3 is as defined above, with a trialkylorthoformate in the presence of an aqueous acid. [Emphasis added.]

20. A process for the preparation of a compound of formula (VII)

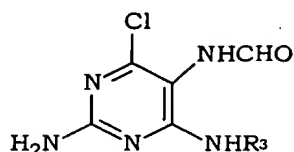


(VII)

wherein R^3 is



comprising reacting a compound of formula (VI)



(VI)

wherein R³ is as defined above with a trialkylorthoformate in the presence of an aqueous acid.

The references relied on by the examiner are:

Shealy et al. (Shealy)	4,728,736	Mar. 1, 1988
Borthwick et al. (Borthwick)	4,857,531	Aug. 15, 1989
Vince (Vince '224)	4,916,224	Apr. 10, 1990
Norbeck et al. (Norbeck)	4,988,703	Jan. 29, 1991
Daluge (Daluge '671)	5,049,671	Sep. 17, 1991
Daluge (Daluge '697)	5,087,697	Feb. 11, 1992
Vince et al. (Vince '607)	5,763,607	Jun. 9, 1998

Harnden (European Patent)	EP 0 413 544 B1	Jan. 2, 1997
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Grant & Hackh's Chemical Dictionary, 5th edition, McGraw-Hill Book Co., pp. 444 and 445

Claims 9, 18, and 22 stand rejected under 35 U.S.C. § 112, second paragraph, as not particularly pointing out and distinctly claiming the subject matter which applicants regard as their invention.

Claims 9 and 18 through 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable "over Daluge '697 in view of Vince '224 or Daluge '671, further in view of Norbeck, Vince '607, Bothwick [sic], or Shealy" (Paper No. 29, page 12).

Claims 9 and 18 through 22 further stand rejected under 35 U.S.C. § 103(a) as unpatentable "over Norbeck, Vince '607, Bothwick [sic] or Shealy, in view of EP 413,544 or Daluge '697" (Paper No. 29, page 17).

A previously entered rejection of claims 19 and 20 under 35 U.S.C. § 112 has been dropped (Paper No. 29, page 2).

Discussion

Respecting the rejection of claims 9, 18, and 22 under 35 U.S.C. § 112, second paragraph, applicants have grouped these claims together (Paper No. 28, section VII.). Accordingly, we shall select claim 9 from this group and shall decide the question of indefiniteness on the basis of that claim alone. See 37 CFR § 1.192(c)(7).

We agree with the examiner's determination that the metes and bounds of claim 9 are unclear in view of applicant's recitation "phosphonyl." We shall not belabor the record with extensive discussion on this point, but refer to the lucid analysis set forth in the Examiner's Answer (Paper No. 29, pages 3 through 6). We find no error in that analysis. Applicants argue that the "correct" term for the group $-P(O)(OH)_2$ is "phosphonyl" (Paper No. 28, page 9). That argument, however, is not supported by evidence in the record. On the contrary, as pointed out by the examiner, the correct term designating $-P(O)(OH)_2$ in the vocabulary of organic chemistry would be "phospho" or "phosphono." See Grant & Hackh's Chemical Dictionary, 5th edition, pp. 444.

The examiner's decision rejecting claim 9 under 35 U.S.C. § 112, second paragraph, is affirmed. As previously indicated, claims 18 and 22 fall together with claim 9. In view of our disposition of this rejection, we find it unnecessary to discuss the terms "glycosidic bond" or "an acyclic group, wherein such acyclic groups [sic] may be optionally substituted with substituents selected from the group consisting of C₁₋₄ alkyl, C₁₋₄ alkoxy, hydroxyl or protected hydroxyl, azido, phosphonyl, and halogen." According to the examiner, claims 9, 18, and 22 also run afoul of 35 U.S.C. § 112, second paragraph, in view of the recitation of those terms.

Respecting the rejection of claims 9 and 18 through 22 under 35 U.S.C. § 103(a) as unpatentable "over Daluge '697 in view of Vince '224 or Daluge '671, further in view of Norbeck, Vince '607, Bothwick [sic] or Shealy," applicants have grouped these claims together (Paper No. 28, section VII.). Accordingly, we shall select claim 20 from this group and shall decide the question of obviousness on the basis of that claim alone. See 37 CFR § 1.192(c)(7).

We agree with the examiner's determination that the subject matter sought to be patented in claim 20 would have been obvious at the time the invention was made to a person having ordinary skill in the art, based on the combined disclosures of Daluge '697 in view of Vince '224 or Daluge '671, further in view of Norbeck, Vince '607, Bothwick, or Shealy. Again, we shall not belabor the record with extensive discussion but refer to the lucid and thorough analysis set forth in the Examiner's Answer (Paper No. 29, pages 12 through 17). We find no error in that analysis. Where, as here, the

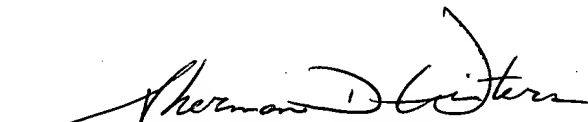
examiner has set forth a comprehensive statement of rejection and a rebuttal to applicants' arguments on appeal, we shall adopt the examiner's position as our own.

The decision, rejecting claim 20 under 35 U.S.C. § 103(a) as unpatentable "over Daluge '697 in view of Vince '224 or Daluge '671, further in view of Norbeck, Vince '607, Bothwick [sic] or Shealy," is affirmed. As previously indicated, claims 9, 18, 19, 21, and 22 fall together with claim 20. In view of our disposition of this appeal, we find it unnecessary to discuss the separate rejection of claims 9 and 18 through 22 under 35 U.S.C. § 103(a) as unpatentable "over Norbeck, Vince '607, Bothwick [sic] or Shealy, in view of EP 413,544 or Daluge '697."

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


Sherman D. Winters
Administrative Patent Judge


William F. Smith
Administrative Patent Judge


Lora M. Green
Administrative Patent Judge

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